

Notice of Allowability

Application No.

09/826,712

Examiner

Thong Q. Nguyen

Applicant(s)

ENGELHARDT ET AL.

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendments of 12/04/03 and 01/13/04 and the Appeal Brief of 8/16/2004.
2. ☒ The allowed claim(s) is/are 1-4, 8-10 and 16-20 which are renumbered as claims 1-12.
3. ☒ The drawings filed on 05 April 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

THONG NGUYEN
PRIMARY EXAMINER
GROUP 2800

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendments filed on 12/04/2003 and 01/13/2004. It is noted that in the amendment of 12/04/2003, applicant has amended claims 1-4, 8-9 and 19, and in the amendment of 01/13/2004, applicant has provided a complete list of claims in respond to the notice of non-compliant issued by the Office on 12/31/2003.

Response to Arguments

2. Regarding to the rejections of claims 1-4, 8-10 and 16-20 under 35 USC 112, second paragraph as set forth in the Office action of 7/31/2003, the amendments to the claims are sufficient to overcome the rejections, and thus the rejections are now withdrawn.

3. Regarding to the rejections of claims 1-4, 8-10 and 16-20 under 35 USC 103, applicant's arguments filed on the Appeal Brief of August 16, 2004 have been fully considered and are persuasive, and thus the rejections to the claims under 35 USC 103 are now withdrawn.

Allowable Subject Matter

4. Claims 1-4, 8-10 and 16-20 are allowed.

5. The following is an examiner's statement of reasons for allowance:

The double confocal scanning microscope having two corrected microscope objectives as claimed in claim 1 is patentable with respect to the cited art, in particular, the reference No. EP 491 289 and the reference No. DE 39 18 412 by

the limitations related to the use of two corrected objectives arranged opposite of each other relative to a specimen so that the longitudinal chromatic aberrations of the two objectives are almost identical and a solution of the microscope is at least the order of magnitude of a theoretically achievable resolution of the microscope. It is noted that while each of the mentioned references discloses a confocal microscope having two objective lenses arranged opposite of each other relative to a specimen; however, the objective lenses of the cited art does not provide the features related to the use of a light source emitting coherent light of various wavelengths and the pair of corrected objective lenses which provided identical longitudinal chromatic aberrations and a solution of the microscope is at least the order of magnitude of a theoretically achievable resolution of the microscope as claimed.

The Examiner regrets to allow the claims after the applicant has filed an appeal Brief; however, applicant's arguments provided in the brief are persuasive on the issue of nonobviousness.

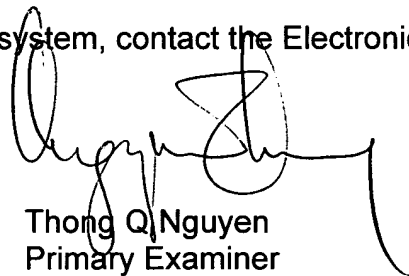
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
